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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,670	11/16/2001	Thomas Hicks	6414-61471	2776
7590 08/16/2004 Marger Johnson & McCollom, P.C. 1030 S.W. Morrison Street Portland, OR 97205			EXAMINER TSOY, ELENA	
			ART UNIT 1762	PAPER NUMBER
DATE MAILED: 08/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/990,670	HICKS, THOMAS	
	Examiner	Art Unit	
	Elena Tsoy	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 and 19-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 and 19-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6/14/04</u> . | 6) <input type="checkbox"/> Other: _____ |

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Response to Amendment

1. Amendment filed on July 27, 2004 has been entered. New claims 22-31 have been added. Claims 4-6, 19-31 are pending in the application.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 4** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Cliffe (US 4,528,232) in view of Taylor et al (US 5,672,413) for the reasons of record as set forth in Paragraph No. 2 of the Office Action mailed on January 27, 2004. The added limitation "which covers the window" does not change the scope of the claim because "a window covering which covers the window" is just "a window covering".
4. **Claims 4, 5, 19-21** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Taylor et al (US 5,672,413) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed on January 27, 2004.
5. **Claims 4, 5, 19-21** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Taylor et al (US 5,672,413) and Cliffe (US 4,528,232),

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further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date).

6. **Claims 4, 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cliffe (US 4,528,232) in view of Pohn (US 4,791,745).

Cliffe is applied here for the same reasons as set forth in Paragraph No. 2 of the Office Action mailed on January 27, 2004. Cliffe further teaches that static self-cling film, which may be of PVC, is used for receiving a printed colored image (See column 1, lines 39-41). However, Cliffe fails to teach that the static cling film has thickness in the range of 4-10 mils (Claim 4) or about 8 mils (Claim 22).

Pohn teaches that PVC static self-cling film such as a static cling 8 mil vinyl can be used for carrying an image thereon (See column 2, lines 65-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a static cling 8 mil vinyl in a process of Cliffe with the expectation of providing the desired self-adhering printed window covering since Pohn teaches that PVC static self-cling film such as a static cling 8 mils vinyl can be used for carrying an image thereon.

It is the Examiner's position that a cling strip for covering window is in fact window covering as claimed because area of coverage is not recited by the claim. It is held that during patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The broadest reasonable interpretation of the

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claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

It is also the Examiner's position that a window covering of Cliffe in view of Taylor et al would have all claimed properties such as allowing light pass through but diffusing it, since window covering is produced by a process identical or substantially identical processes to that of claimed invention.

7. **Claims 4, 5, 19-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date).

Charley et al are applied here for the same reasons as set forth in Paragraph No. 3 of the Office Action mailed on January 27, 2004. Charley et al further teach that any static self-cling film, including static cling 6 mil vinyl, can be used (See column 1, lines 39-41). However, Charley et al fail to teach that the static cling film has thickness in the range of 4-10 mils (Claim 4) or about 8 mils (Claim 22).

Pohn teaches that static cling 8 mil vinyl can be used for carrying an image thereon (See column 2, lines 65-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a static cling 8 mil vinyl in a process of Charley et al with the expectation of providing the desired self-adhering printed window covering since Pohn teaches that static cling 8 mils vinyl can be used for carrying an image thereon.

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Cliffe, Rega et al, GB 2324381, and advertisement for Solar Stat are applied here for the same reasons as set forth in Paragraph No. 3 of the Office Action mailed on January 27, 2004.

8. **Claims 6, 23, 26, 27, 29, 31** are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, and further in view of Cooledge et al (US 5,258,214).

Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat, as applied above, fail to teach that a static cling window covering covers the entire surface of the window.

Cooledge et al teach that a static cling window covering with a printed image may be made to cover any surface area of the window (See Fig. 3; column 4, lines 13-17).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made a static cling window covering of Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat to cover any area of the window including the entire surface of the window, with the expectation of providing the desired visual effect, since Cooledge et al teach that a static cling window covering with a printed image may be made to cover any surface area of the window not just to cover borders.

9. **Claim 24** is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, and further in view of Collier (US 4,684,675).

Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat, as applied above, fail to teach that matte varnish is applied before applying a color image.

Collier teaches that applying first a matte lacquer (varnish) to PVC film of 2-8 mils thickness (See column 3, lines 15-19) before applying a color image provides the PVC film with desired non-streaking properties (See Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied first a matte lacquer (varnish) to PVC film of Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat before applying a color image with the expectation of providing the PVC film with desired non-streaking properties, as taught by Collier.

10. **Claim 25** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cliffe (US 4,528,232) in view of Taylor et al (US 5,672,413) (or in view of Pohn (US 4,791,745)), further in view of Chmielnik (US 5,617,790).

Cliffe in view of Taylor et al/Pohn, as applied above, fails to teach that colors are provided by cyan, magenta and yellow inks.

Chmielnik teaches that the individual colors are provided by inks in the primary colors of cyan, magenta and yellow.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used primary colors of cyan, magenta and yellow in inks of Cliffe in view of Taylor et al/Pohn with the expectation of providing the desired color images, Chmielnik teaches

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that the individual colors are provided by inks in the primary colors of cyan, magenta and yellow.

11. **Claim 25** is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Taylor et al (US 5,672,413) (or in view of Pohn (US 4,791,745)) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, and further in view of Chmielnik (US 5,617,790).

Charley et al, as applied above, fail to teach that water-based inks are cyan, magenta and yellow inks.

Chmielnik teaches that the individual colors provided by water-based printing inks, usually in the primary colors of yellow, red (magenta), blue (cyan) and black, can be used to print color images (See column 3, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used water-based printing inks, usually in the primary colors of yellow, red (magenta), blue (cyan) as water-based inks of Charley et al (in view of Taylor et al/Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat) with the expectation of providing the desired color image, since Chmielnik teaches that the individual colors provided by water-based printing inks, usually in the primary colors of yellow, red (magenta), blue (cyan) and black, can be used to print color images.

12. **Claim 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, further in view of Cooledge et al (US 5,258,214), and further in view of Collier (US 4,684,675).

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Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat, in view of Cooledge et al, as applied above, fail to teach that matte varnish is applied before applying a color image.

Collier teaches that applying first a matte lacquer (varnish) to PVC film of 2-8 mils thickness (See column 3, lines 15-19) before applying a color image provides the PVC film with desired non-streaking properties (See Abstract).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied first a matte lacquer (varnish) to PVC film of Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat in view of Cooledge et al before applying a color image with the expectation of providing the PVC film with desired non-streaking properties, as taught by Collier.

13. **Claim 30** is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, further in view of Cooledge et al (US 5,258,214), and further in view of Chmielnik (US 5,617,790).

Charley et al, as applied above, fail to teach that water-based inks are cyan, magenta and yellow inks.

Chmielnik teaches that the individual colors provided by water-based printing inks, usually in the primary colors of yellow, red (magenta), blue (cyan) and black, can be used to print color images (See column 3, lines 5-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used water-based printing inks, usually in the primary colors of yellow, red

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(magenta), blue (cyan) as water-based inks of Charley et al (in view of Taylor et al/Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat in view of Cooledge et al) with the expectation of providing the desired color image, since Chmielnik teaches that the individual colors provided by water-based printing inks, usually in the primary colors of yellow, red (magenta), blue (cyan) and black, can be used to print color images.

Response to Arguments

14. Applicants' arguments filed July 27, 2004 have been fully considered but they are not persuasive.

(A) Applicants argue that Charley et al utilize a layer of opaque white imprinting film and thus the film and printed translucent colored image would not allow light to pass. See examples of Charley et al at column 2, lines 40-60.

The Examiner respectfully disagrees with this argument. Mirror-image printing is a preferred method of Charley et al. However, at column 2, lines 47-60, Charley et al teach printing without the use of a layer of opaque white.

It is held that PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN. See *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See MPEP 2123.

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Therefore, **non-preferred** method of Charley et al **without the use** of a layer of opaque white is as relevant as a preferred method with the use of a layer of opaque white.

(B) Applicants argue that teaching of Charley et al not to use lithographic printing should not be ignored because of numerous disadvantages.

However, Charley et al do not teach that a colored image cannot be printed with lithographic printing. Numerous disadvantages include difficult of handling numerous sheets of paper. Thus, according to Charley et al, flexographic printing is preferred method of printing. One of ordinary skill in the art at would understand that lithographic printing can be also successfully used if not numerous sheets of paper are used.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elena Tsoy
Primary Examiner
Art Unit 1762

ELENA TSOY
PRIMARY EXAMINER

ETsoy

August 13, 2004